

Before The Board of Patent Appeals and Interferences

For:			
PROGRAM-UPDATE PRIORITIZATION ACCORDING TO PROGRAM-USAGE TRACKING			
Applicant: James Russell CURTIS et al.		Attorney Docket No.: 200314220-1	
Serial No.: 10/691,028 (5010)	Filed: 2003-Oct-22	Art Unit: 2192	Examiner: DAO, Thuy Chan

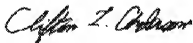
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Reply Brief

(Identification Page)

This Reply Brief is an augmented version of the Appeal Brief filed 2009-Jul-15. Specific responses to the Examiner's Answer of 2009-Nov-16 are marked as such in the Argument section.

Respectfully submitted
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REAL PARTY IN INTEREST

The real parties in interest are

Hewlett-Packard Company, a Delaware corporation; and

Hewlett-Packard Development Company, L.P., a Texas limited partnership and wholly owned affiliate of Hewlett-Packard Company, and assignee of record.

RELATED APPEALS AND INTERFERENCES

None.

There are no related appeals or interferences.

STATUS OF CLAIMS

Claims 1, 3-6, and 8-10 are pending in the application.

Claims 2 and 7 have been canceled.

Claims 1, 3-6, and 8-10 are rejected.

The rejections of Claims 1, 3-6, and 8-10 are on appeal.

STATUS OF AMENDMENTS

All amendments have been entered. There are no unentered amendments.

SUMMARY OF CLAIMED SUBJECT MATTER

Concise Explanation of Claims

Independent Claim 1 relates to a method (M1, Fig. 2, ¶¶19-24) comprising:

- launching (S02, Fig. 2, ¶19) an application (20, Fig. 1, ¶¶16-18) on a user system (13, Fig. 1, ¶16);

- tracking usage (S03, Fig. 2, ¶19) of said application so as to generate usage data (31, Fig. 1, ¶19) on said user system;

- accessing (S04, Fig. 2, ¶20) an update site (11, Fig. 1, ¶16) from said user system;

- transferring (S05, Fig. 2, ¶21) said usage data from said user system to said update site;

- said update site prioritizing (S07, Fig. 2, ¶23) updates for said application at least in part as a function of said usage data; and

- said update site presenting (S08, Fig. 2, ¶23) to a user a list of said updates as prioritized in said prioritizing step.

Claim 3 relates to a method as recited in Claim 1 wherein said user selects (S09, Fig. 2, ¶24) one or more of said updates for said application.

Claim 4 relates to a method as recited in Claim 3 wherein said selected ones of said updates are installed (S11, Fig. 2, ¶¶24-25) so as to modify said application.

Claim 5 relates to a method as recited in Claim 1 wherein further development of said application is directed (¶26) in part as a function of said usage data.

Independent Claim 6 relates to a computer program product (AP1, Fig. 1, ¶16) comprising computer-readable storage media encoded with a set of computer programs including:

- a usage data evaluator (23, Fig. 1, ¶16) for receiving and evaluating raw usage data provided by a user computer system (13, Fig. 1, ¶16) regarding a version of a software application installed thereon, said usage data evaluator providing evaluated usage data;

- an update prioritizer (25, Fig. 1, ¶16) for prioritizing updates available for said version at least in part as a function of said evaluated usage data; and

- a web interface (21, Fig. 1, ¶16) for communicating with said user computer system via a browser on said user system so as to present to a user of said user computer system a list of said updates as prioritized by said prioritizer.

Claim 8 relates to a product as recited in Claim 6 wherein said web interface specifies, for at least some of said updates, advantages over said version of said application.

Claim 9 relates to a product as recited in Claim 6 further comprising a usage-tracking module (30, Fig. 1, ¶17) installed on said user computer system.

Claim 10 relates to a product as recited in Claim 9 wherein said usage-tracking module is integrated with said version of said application.

GROUND OF REJECTION TO BE REVIEWED

All outstanding grounds of rejections are to be reviewed. These grounds are set forth below.

Claims 1, 3-6, and 8-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 2004/0003266 A1 to Moshir et al., "Moshir" herein, in view of US Patent No. 6,678,888 to Sakanishi, "Sakanishi" herein.

ARGUMENTS

[01] ARGUMENTS FOR REVERSING REJECTIONS FOR OBVIOUSNESS

[02] Item 7 of the Final Action of 2009-Apr-16 rejects Claims 1, 3-6, and 8-10 under 35 U.S.C. 103(a) as being unpatentable over Moshir in view of Sakanishi.

[03] For the purposes of these rejections, the rejected claims are divided into: Group 1 consisting of Claims 1 and 3-5; Group 2 consisting of Claim 5; and Group 3 consisting of Claims 6 and 8-10.

[04] GROUP 1: CLAIMS 1, 3, and 4

[05] Item 7 of the Final Action rejects Claims 1, 3 and 4 for obviousness given Moshir in view of Sakanishi. These rejections should be reversed because of the following Examiner errors: 1) a failure to fully identify the differences between the claimed invention and the state of the art as required by *Graham v. John Deere*; 2) a failure to accurately characterize the level of skill in the art as required by *Graham v. John Deere*; 3) a failure to provide a viable motivation for modifying Moshir in accordance with the teachings of Sakanishi; and 4) a failure to establish that the proposed combination would meet the claim limitations.

[06] STATE OF THE ART

[07] The Final Action cites Moshir as representative of the state of the art. Moshir addresses a problem referred to as "administrator

agony” by automating much of the updating process that system administrators previously managed manually. Moshir's teachings are toward less rather than more administrator involvement in updating target systems. User involvement in such updating is even more limited, e.g., limited to identifying problems that might be addressed by an update.

[08] Claim 1 requires “said update site presenting to a user a list of said updates as prioritized in said prioritizing step”.

[09] The Final Action asserts that this limitation is disclosed at FIG. 7, block 706, [0144]–[0147]; FIG. 5, [0129], notification means 516, [0132]; [158] and [0187]). However, none of these sources in Moshir disclose this “presenting prioritized list” limitation.

[10] Moshir Fig. 7 does include a block 706 labeled “proposed update list”. So, Fig. 7 discloses a list, but does not disclose that it is prioritized or that it is presented to a user. Paragraphs [0144]–[0147] teach that when list 706 is generated, an administrator is notified. However, Moshir does not teach that the list is presented to the administrator, let alone to a user. Also, paragraphs [0144]–[0147] do not disclose that the list is prioritized.

[11] Moshir Fig. 5 discloses an update list 536, but does not disclose that it is prioritized or that it is presented to a user. Paragraph [0129] discloses a “list of agents”, but this is not a list of updates, is not disclosed to be prioritized, and is not disclosed to be presented to a user. Fig. 5 does disclose a notification means 516, but this is not a disclosure of a list of updates, a prioritized list, or presenting a list. Paragraph [0132] does not disclose a list, whether prioritized or not and whether or not presented to a user.

[12] Paragraph [0158] discloses presenting a report matrix to an administrator, but does not disclose a list, prioritized or not. Paragraph [0187] does not disclose a list, whether prioritized or not and whether presented or not.

[13] Thus, an exhaustive search of the portions of Moshir relied on for a disclosure of a prioritized update list presented to a user demonstrates that the Examiner's characterization of the state of the art is in error. In fact, Moshir fails to disclose all the claim elements it is relied on to disclose. Accordingly, the rejection of Claim 1 should be reversed.

[14] ****Response to Examiner's Answer****

[15] *This is a response to the Examiner's Answer, Section (10) Response to Argument, GROUP 1, Claims 1, 3, 4, part a), Examiner's Answer (EA) pages 11-12.*

[16] Appellant will stipulate: 1) that Moshir prioritizes in that Moshir distinguishes between critical (high-priority) and non-critical (low-priority) updates; and 2) that Moshir presents an update list to a user. The Examiner has failed to establish that the update list is prioritized.

[17] For a list to be prioritized, two conditions must be met: 1) the list must contain items of different priority; and 2) list items must be order in the list according to their priority. Regarding (2), Moshir does not disclose, for example, that the update list presents critical (high-priority) items before non-critical (low-priority) items. Regarding (1), Moshir does not disclose that the list presents any non-critical (low-priority) updates; therefore, the list cannot be prioritized because all items have the same (critical/high) priority.

[18] Taken as a whole, Moshir teaches a "proactive" method of handling critical updates. Implicitly, the conventional user-initiated approach to discovering and installing updates is satisfactory for non-critical updates but not pro-active enough for critical updates. Accordingly, Moshir provides convenient copies of critical updates in a cache prior to their installation and presents the user with a list of the cached critical (high-priority) updates. The non-critical (low-priority) updates are not treated in this manner. They only appear in the cache after they have been deployed, presumably due to a user-initiated update. Since the non-critical (low-priority) updates are not being treated proactively, there is no reason to present or include them in Moshir's update list.

[19] While the foregoing is merely an interpretation, there is nothing in Moshir that conflicts with an interpretation of Moshir in which the list presents only critical (high-priority) updates and, therefore, is not prioritized. Specifically, the three passages from Moshir quoted in the Examiner's Answer from the bottom of page 12 to the top of page 13 do not disclose that the update list is prioritized. Thus, the Examiner has failed to establish that Moshir discloses an update list that is prioritized. Since the Examiner has failed to establish that Moshir discloses a list in which updates are prioritized, the rejections should be reversed.

[20] ****End EA Response****

[21] **LEVEL OF SKILL IN THE ART**

[22] The Final Action relies on Sakanishi to represent the level of skill in the art. More specifically, the Final Action asserts that

Sakanishi discloses the Claim 1 limitation “said update site prioritizing updates for said application at least in part as a function of said usage data”. However, Sakanishi does not disclose this limitation.

[23] The Final Action asserts that Sakanishi discloses “usage data” at Fig. 3, and column 7, lines 23–40. While this figure and this passage do disclose software information, they do not disclose any information regarding a user’s use of the software; in other words, no usage information is disclosed.

[24] Sakanishi, Fig. 12, and a passage extending from column 9, line 56 to column 10, line 10, also fail to disclose usage data. However, the passage does indicate that a user may enter “information specifying a priority level”; this suggests that update priorities are simply assigned rather than being generated as a function of usage data. (Sakanishi, Fig. 7 teaches “affected software” as asserted in the Final Action, but does not teach usage data or prioritizing.)

[25] Referring to the Final Action on page 6, Sakanishi Fig. 12 does disclose that priority levels can be assigned to updates, but does not disclose that these priority levels are based on usage data. Sakanishi, column 5, lines 27–32 discusses priority levels, but does not disclose that they are a function of usage data. Referring to the Final Action on page 7, Sakanishi, column 8, lines 16–28 discloses priority levels, but not that they are a function of usage data. Rather than disclose a prioritized list, Sakanishi discloses non-prioritized tables with columns under which priority levels can be specified.

[26] Thus, an exhaustive analysis of the portions of Sakanishi relied on for a disclosure of the Claim 1 limitation “said update site

prioritizing updates for said application at least in part as a function of said usage data" demonstrates that the Final Action has failed to establish that the limitation is disclosed by Sakanishi. **Thus, the Final Action has erred in characterizing the level of skill in the art; for this second reason, the rejection for obviousness of Claim 1 should be reversed.**

[27] ****Response to Examiner's Answer****

[28] *This is a response to the Examiner's Answer, Section (10) Response to Argument, GROUP 1, Claims 1, 3, 4, Examiner's Answer (EA), part b) pages 13-16.*

[29] The usage data referred to in Claim 1 is generated by *tracking usage*, i.e., "choices made by a user" and "tasks (an) application performs". (See ¶18 of the specification). Examples given in the specification include "configuration data" (which can be set by a user), "command selection", and "nature of work done by the application". Sakanishi does not disclose usage data that is generated by tracking usage.

[30] The Examiner's Answer asserts that "software usage priorities" disclosed by Sakanishi qualifies as the claimed "usage data". However, Sakanishi, column 3, lines 25-28, (the first sentence of the passage quoted in the Examiner's Answer from the bottom of page 14 to the top of page 15) makes it clear that Sakanishi's software usage priorities are "set when a distribution is requested" rather than generated by tracking usage. Therefore, the Examiner has failed to establish that Sakanishi's "software usage priorities" qualify as the claimed "usage data".

[31] The Examiner's opinion to the contrary appears to be based on a logical fallacy. As the Examiner's Answer points out, ¶10 of the specification states "Data regarding usage is gathered on the user's computer system." The Examiner appears to fallaciously infer that because usage data is gathered on the user's computer system, that all data gathered on the user's computer system qualifies as usage data. In general, data other than usage data is stored on a computer along with usage data.

[32] Accordingly, "usage data" does not exclude usage data/information such as "version" and/or "usage priority level" of the already installed software (that is to say, gathered from the user's computer system). (*EA, lower middle of page 15*). Note that when usage data is collected, it may be associated with an application and a version of that application; however, this does not mean that the version number itself qualifies as usage data.

[33] The fact that version information and usage priority levels can be gathered from the user's computer system does not qualify them as the claimed usage data that is gathered by tracking usage. Since the Examiner recognizes that Moshir does not disclose the claimed usage data and has failed to establish that Sakanishi discloses the claimed usage data, and, therefore, does not disclose prioritizing updates as a function of usage data, the rejections should be reversed.

[34] ****End EA Response****

[35] **No Motivation to Combine**

[36] The Final Action, page 7, proposes as the motivation for modifying Moshir would be to "efficiently handle software

distribution." However, it is apparent that the method disclosed by Moshir is already more efficient than the method disclosed by Sakanishi. Sakanishi requires a user to make requests and assign priority levels to those requests; Moshir imposes almost no burden on a user and imposes a greatly reduced burden on an administrator. Accordingly, one skilled in the art would not be motivated to modify Moshir in accordance with the teachings of Sakanishi due to the increased burden on a user. **Since one would not be motivated to combine the references as proposed, the rejection for obviousness of Claim 1 should be reversed for this third reason.**

[37] **Response to Examiner's Answer**

[38] *This is a response to the Examiner's Answer, Section (10) Response to Argument, GROUP 1, Claims 1, 3, 4, Examiner's Answer (EA), part c) pages 16-17.*

[39] In the Final Action, the Examiner argued that one skilled in the art at the time the invention was made would have been motivated to modify Moshi in accordance with the teachings of Sakanishi "to efficiently handle software distribution as suggested by Sakanishi (e.g., col.3: 25-37)." In the Appeal Brief, Appellant argued (Appeal Brief, Arguments, page 13, paragraph 21) that Moshir already imposes less waste than does Sakanishi.

[40] Significantly, the Examiner's Answer did not address the substance of this argument that the proposed modification would not improve Moshir's efficiency. (The Examiner's answer merely elaborated on the original reasoning given in the Final Action). Accordingly, Appellant's arguments should be considered undisputed and the

proposed motivation to combine should be considered repudiated. Since one skilled in the art would not have been motivated to modify Moshir in accordance with Sakanishi as proposed, the rejections for obviousness should be reversed.

[41] In addition, Moshir does not wastefully install any updates. Moshir installs only critical updates and uses “fingerprints” to determine whether or not to install an update; so no update will be installed needlessly. Accordingly, one skilled in the art would not be motivated to modify Moshir in accordance with the teachings of Sakanishi, as the latter offers no reductions in wastefulness compared to the former.

[42] ****End EA Response****

[43] Proposed Combination does not meet claim limitations

[44] The Final Action does not explain how Moshir is to be modified in accordance with the teachings of Sakanishi. Are Moshir's lists to be replaced by Sakanishi's tables? Are the tables to have Sakanishi's data in them or Morshir's. Is Moshir's user, who does not participate in the update process, supposed to be modified so that the user enters priority levels and makes update decisions? The Final Action leaves the reader with the challenge of figuring out the character of the proposed modification.

[45] However, whatever the character of the proposed combination, it appears that it would not meet all the limitations of Claim 1. Neither reference discloses prioritizing updates as a function of usage data. Moshir discloses prioritizing based on criticality; Sakanishi discloses assigning priority levels without specifying the basis for assigning the

priority levels. Since neither reference discloses prioritizing updates based on usage, the proposed combination of references would also fail to meet the limitation of prioritizing updates as a function of usage. **Since the proposed combination of references, whatever its actual character, would not meet all the limitations of Claim 1, the rejection of Claim 1 for obviousness should be reversed for this fourth reason.**

[46] ****Response to Examiner's Answer****

[47] *This is a response to the Examiner's Answer, Section (10) Response to Argument, GROUP 1, Claims 1, 3, 4, Examiner's Answer (EA), part d) page 17.*

[48] The Examiner argues that there is a reasonable interpretation of "list" that would encompass a table. Appellant has searched the Internet for such an interpretation and has not found a definition of list that includes "table" and has not found a reference to a table as a "list". This is not to say that no such interpretation exists, but only that the Examiner has failed to establish that the plain meaning of "list" includes tables.

[49] The Examiner asserts that Moshir's disclosure requires a user to select the date and time to deploy an update package. However, what Moshir actually discloses in paragraph [0025] is that the administrator, not the user, selects a date and time. In any event, selecting a date and time is still less human involvement than Sakanishi requires.

[50] Since all claims require a prioritized list of updates prioritized according to usage data, and since neither Moshir nor Sakanishi discloses a prioritized list of updates, let alone one prioritized

according to usage data, the rejections of Claims 1, 3, and 4 should be reversed.

[51] ****End EA Response****

[52] **Claims 3 and 4**

[53] The rejections of Claims 3 and 4 for obviousness should also be reversed based on their dependency from Claim 1.

[54] **GROUP 2: Claim 5**

[55] Item 7 of the Final Action rejects Claim 5 for obviousness given Moshir in view of Sakanishi. This rejection should be reversed because of the following Examiner errors: 1) a failure to fully identify the differences between the claimed invention and the state of the art as required by *Graham v. John Deere*; 2) a failure to accurately characterize the level of skill in the art as required by *Graham v. John Deere*; 3) a failure to provide a viable motivation for modifying Moshir in accordance with the teachings of Sakanishi; and 4) a failure to establish that the proposed combination would meet the claim limitations.

[56] The rejection of Claim 5 should be reversed for all the reasons given above for Claim 1, from which Claim 5 depends. Claim 5 adds the limitation “wherein further development of said application is directed in part as a function of said usage data.”. The Final Action asserts that this limitation is disclosed somewhere in paragraphs [0065]–[0070], but a careful review of these paragraphs did not discover any teachings to this effect. **For this additional reason, the rejection of Claim 5 should be reversed.**

[57] ****Response to Examiner's Answer****

[58] *This is a response to the Examiner's Answer, Section (10) Response to Argument, GROUP 2, Claim 5, EA page 17.*

[59] **Usage Data Directing Further Development**

[60] Claim 5 adds a limitation "wherein further development of said application is directed in part as a function of said usage data". The Examiner's Answer establishes that Moshir suggests "further development" in that Moshir discloses [0069]–[0070], "an incremental software patch", "an update to an old program", "an update of the update agent").

[61] The issue remains whether the limitation that this further development is "*directed in part as a function of said usage data*". Moshir does not suggest this. The Examiner's Answer appears to rely on Sakanishi, FIG. 12, Version and Priority level ("usage data" as claimed) of Already Installed Software for a connection between directing further development and usage data. However, as pointed out above, Sakanishi's version and priority level do not qualify as usage data as that term is used in the claims. Furthermore, Sakanishi does not suggest using version and priority level in directing further development. **Since the Examiner has failed to establish that the additional limitation of Claim 5 would be obvious given the proposed combination of references, the rejection of Claim 5 should be reversed for this additional reason.**

[62] ****End EA Response****

[63] **GROUP 3: Claims 6 and 8-10**

[64] Item 7 of the Final Action rejects Claims 6 and 8-10 for obviousness given Moshir in view of Sakanishi. These rejections should be reversed because of the following Examiner errors: 1) a failure to fully identify the differences between the claimed invention and the state of the art as required by *Graham v. John Deere*; 2) a failure to accurately characterize the level of skill in the art as required by *Graham v. John Deere*; 3) a failure to provide a viable motivation for modifying Moshir in accordance with the teachings of Sakanishi; and 4) a failure to establish that the proposed combination would meet the claim limitations.

[65] **STATE OF THE ART**

[66] **Overview**

[67] The Final Action, page 8, cites Moshir as representative of the state of the art. Moshir addresses a problem referred to as “administrator agony” by automating much of the updating process that system administrators previously managed manually. Moshir’s teachings are toward less rather than more administrator involvement in updating target systems. User involvement in such updating is even more limited, e.g., limited to identifying problems that might be addressed by an update.

[68] **Data Evaluator**

[69] The Final Action, page 8, asserts that Moshir discloses the Claim 6 limitation “a *usage data evaluator for receiving and evaluating raw*

usage data received provided by a user computer system (e.g., [0010]–[0018]; FIG. 6, usage/software/hardware info 604–608, [0099]–[0100]);". As to Moshir, [0010]–[0018], these paragraphs describe the administrator agony discussed above, but not a usage data evaluator. Also, paragraphs [0010]–[0018] are part of the background section of Moshir and are not directly related to the embodiment represented in Moshir, Fig. 6. Moshir Fig. 6 discloses "usage info 604", but not a usage data evaluator. [0099] discloses a "discovery agent 548 that inventories usage info 604; however, Moshir does not disclose that discovery agent 548 evaluates usage info 604. [0100] does not address usage info 604 directly but does indicate that some information (that might include usage info 604) is sent and possibly compressed and encrypted. **None of the figures or passages relied on in the Final Action for a disclosure of a usage data evaluator actually discloses a usage data evaluator or discloses that usage data is evaluated.**

[70] ****Response to Examiner's Answer****

[71] *This is a response to the Examiner's Answer, Section (10) Response to Argument, GROUP 3, Claims 6 and 8–10, part (a), EA pages 18–19.*

[72] **Usage Data**

[73] Claim 6 requires a usage data evaluator for receiving and evaluating raw usage data provided by a user computer system regarding a version of a software application installed thereon". As the Examiner's Answer points out, Moshir discloses "usage information 604"; however, Moshir does not provide any details of what "usage information 604" entails so it is not possible to determine whether it refers to the claimed raw usage data or some pre-set information such as intended use.

[74] Evaluating Usage Data

[75] Moshir, Fig. 8, step 820 is captioned "Compare Gathered Info to Fingerprint". Moshir, paragraph [0096] explains that a fingerprint defines how to determine if a given software package/incremental patch has been previously installed. A fingerprint may also define a minimum hardware/software configuration necessary for the patch installation. It does not appear from this description that a fingerprint contains any information that can be compared to raw usage data. Thus, it appears that step 820 does not involve comparing o evaluating raw usage data.

[76] ****End EA Response****

[77] Update Prioritizer

[78] The Final Action, page 8, asserts that Moshir discloses the Claim 6 limitation of "*an update prioritizer for prioritizing updates available for said version (e.g., [0149]–[0152], [0181]);*". Paragraphs [0149]–[0152] address "critical patches". However, they do not disclose a prioritizer for prioritizing these critical patches.

[79] Paragraph [0149] mentions Microsoft, a company that identifies some of its patches as “critical”. There is no reason to believe that Moshir is doing more than relying on a software vendor’s own characterization of a patch or update as “critical”. There is no basis for assuming that Moshir requires a prioritizer to determine what updates are critical. In any event, Moshir does not disclose an update prioritizer. Likewise, while paragraph [0181] discusses “critical”, “high-priority”, and “security-related” patches, the further reference to “Microsoft” suggests that these characterizations are provided by Microsoft and that Moshir does not require a prioritizer to assign these characterizations. **Again, in any event, and contrary to the assertion in the Final Action, Moshir does not disclose an update prioritizer.**

[80] ****Response to Examiner’s Answer****

[81] *This is a response to the Examiner’s Answer, Section (10) Response to Argument, GROUP 3, Claims 6 and 8–10, part (b), EA pages 19–20.*

[82] **Update Prioritizer**

[83] Appellant acknowledges that Moshir distinguishes critical (high-priority) updates from non-critical (low-priority) updates. However, Moshir does not disclose an update prioritizer other than Microsoft Corporation, which does identify updates as critical or non-critical. However, Microsoft Corporation is not included as a program encoded on computer-readable storage media, as required in Claim 6.

[84] In the Appeal Brief, page 17, paragraph 35, Appellant argued:

[85] "Paragraph [0149] mentions Microsoft, a company that identifies some of its patches as "critical". There is no reason to believe that Moshir is doing more than relying on a software vendor's own characterization of a patch or update as "critical".

[86] It should be noted that the Examiner's Answer does not respond to the substance of this argument. Instead, the Examiner presents a series of four passages from Moshir, none of which address the issue raised in the Appeal Brief. For example, one of the passages, presented at the top of page 20, reads as follows:

[87] By contrast, the present invention can provide notification 824 of critical updates to computers in a proactive manner, whether or not they have Internet access

[88] This passage seems irrelevant in that it does not disclose an update prioritizer. Likewise, the other three passages disclose critical updates, but do not disclose an update prioritizer for determining which updates are critical. Instead, Moshir may be relying on manufacturers' characterizations of their patches as "critical" or "non-critical". Thus, the Examiner's Answer does not address or directly dispute Appellant's specific arguments.

[89] Prioritized List

[90] As mentioned earlier, Moshir does not disclose that Moshir's update list includes any non-critical (low-priority) updates. All updates in the list are critical (high-priority). Moshir does not disclose that the updates that are one the update list are prioritized. While the Examiner's Answer repudiates Appellant's arguments on this topic, the passages and figures in Moshir cited from the bottom of page 20 through page 21 are irrelevant to the issue at hand.

[91] **End EA Response**

[92] Web Interface

[93] The Final Action, page 8, asserts that Moshir discloses the Claim 6 limitation of "a web interface for communicating with said user computer system via a browser on said user system so as to present to a user of said computer system a list of said contents as prioritized by said prioritizer (e.g., FIG. 7, block 706, [0144]–[0147]; FIG. 5, [0129], notification means 516, [0132]; [158] and [0187])." Block 706 of Moshir Fig. 7 is labeled "proposed update list".

[94] However, Fig. 7 does not disclose that list 706 is prioritized. Paragraph [0144] discusses factors considered in generating list 706; however, usage data is not one of the factors and no mention is made of prioritizing list 706. Paragraphs [0145]–[0147] discuss how list 706 is used, but do not discuss factors involved in creating list 706 and do not disclose that it is prioritized. Fig. 5 discloses an update list 536, but does not disclose that it is prioritized. Paragraph [0129] discloses that an update server will make packages available one at a time; however, no relationship to a list is disclosed and there is no

disclosure that the order is based on usage data. Paragraph [0132] mentions placing a location reference on a list, but not that the list is prioritized. Paragraph [0158] does not disclose a web interface, a list, or usage data. Paragraph [0187] discloses patches that do and do not meet a patch baseline policy; however, there is no mention of a list, a web interface, or usage data. **Thus, contrary to the assertion in the Office Action, the cited portions of Moshir do not disclose the Claim 6 limitation of a “a web interface for communicating with said user computer system via a browser on said user system as to present to a user of said computer system a list of said contents as prioritized by said prioritizer”.**

[95] Conclusion

[96] The foregoing demonstrates that Moshir does not actually disclose the Claim 6 limitations the Final Action relies on Moshir to disclose. Accordingly, the Final Action has failed to identify accurately the distinctions between the claimed invention and the state of the art. **Accordingly, the Final Action fails to meet the requirements of *Graham v. John Deere*, and the rejection of Claim 6 should be reversed for this first reason.**

[97] **Response to Examiner's Answer**

[98] *This is a response to the Examiner's Answer, Section (10) Response to Argument, GROUP 3, Claims 6 and 8-10, part c), EA pages 20-21.*

[99] Web Interface

[100] As to the issue of whether a web interface is involved in presenting the list, it is noted that Instant Messaging is not tied to the Web. Instant messaging predates the Internet and the World Wide Web. So the fact that Moshir discloses "Instant Message" does not meet the Claim 6 requirement of a "web interface".

[101] ****End EA Response****

[102] **LEVEL OF SKILL IN THE ART**

[103] The Final Action recognizes that Moshir does not disclose "an update prioritizer for prioritizing updates available for said version at least in part as a function of said evaluated usage data". The Final Action (bottom of page 9) asserts that Sakanishi discloses "*an update prioritizer for prioritizing updates available for said version at least in part as a function of said evaluated usage data* (e.g., FIG. 7 explicitly teaches Affected software." As the Final Action asserts, Fig. 7 teaches "affected software", which presumably relates to the claimed "version". However, Fig. 7 does not disclose the prioritizer of Claim 6.

[104] The Final Action refers to Sakanishi, Fig. 12, an annotated version of which is presented on Page 9 of the Office Action. Fig. 12 discloses several tables, three of which include columns labeled "priority", implying some prioritization has occurred. However, Fig. 12 does not disclose the claimed prioritizer. It is noted that the priorities may have been user assigned, in which case, Sakanishi would not need the claimed prioritizer. Also, Fig. 12 does not disclose that the prioritization is based on usage data as claimed.

[105] The Final Action, bottom of page 9, quotes Sakanishi, column 5, lines 27-32. This passage discusses comparing priority levels, but

does not disclose a prioritizer or the use of usage data. The Final Action also quotes Sakanishi, column 8, lines 16–28. This passage reiterates that the tables of Fig. 6 include entries specifying priority levels. However, this passage does not disclose a prioritizer or usage data. **Thus, Sakanishi does not disclose the claimed prioritizer and does not disclose that priorities are assigned as a function of usage data.**

[106] The Final Action, page 8, asserts that Sakanishi discloses “*usage data* (e.g., FIG. 3, col.7: 23–40; FIG. 12, col.9: 56 – col. 10: 10);”. Fig. 3 discloses hardware data and software data, but no usage data. Sakanishi, column 7, lines 23–40, mentions “utilization of data” (line 39), but not usage data. Fig. 12 does not disclose usage data. Sakanishi, column 9, line 56 to column 10, line 10 discloses that a user may enter information specifying a priority level, but does not disclose usage data or that that the priority level is a function of usage data. **Thus, the Final Action fails to establish that Sakanishi discloses usage data.**

[107] The Final Action, page 10, asserts that Sakanishi discloses “*a web interface for communicating with said user computer system via a browser on said user system as to present to a user of said computer system a list of said contents as prioritized by said prioritizer* (e.g., FIG. 25–26, col.15: 32–64).” However these figures and the passage do not refer to a web interface. Also, while tables are disclosed, no list is disclosed. Also, usage data is not involved in these tables. **Since the Final Action fails to accurately characterize the level of skill in the art as required by *Graham v. John Deere*, the rejection of Claim 6 for obviousness should be reversed for this second reason.**

[108] ****Response to Examiner's Answer****

[109] *This is a response to the Examiner's Answer, Section (10) Response to Argument, GROUP 3, Claims 6 and 8-10, part d), EA pages 22-24.*

[110] The Examiner argues that Sakanishi discloses usage data. However, what Sakanishi discloses are usage priority levels, which refer to something set when a distribution is requested and is not usage data as defined in the specification as involving what a user does with an application and what the application does in response. (Specification, ¶18). Since Sakanishi does not disclose usage data, Sakanishi cannot render *"an update prioritizer for prioritizing updates available for said version at least in part as a function of said evaluated usage data"* obvious.

[111] ****End EA Response****

[112] **LACK OF MOTIVATION**

[113] The Final Action, page 10, proposes as the motivation for modifying Moshir would be to "efficiently handle software distribution." However, it is apparent that the method disclosed by Moshir is already more efficient than the method disclosed by Sakanishi. Sakanishi requires a user to make requests and assign priority levels to those requests; Moshir imposes almost no burden on a user and imposes a greatly reduced burden on an administrator. Accordingly, one skilled in the art would not be motivated to modify Moshir in accordance with the teachings of Sakanishi due to the increased burden on a user. **Since one would not be motivated to**

combine the references as proposed, the rejection for obviousness of Claim 6 should be reversed for this third reason.

[114] ****Response to Examiner's Answer****

[115] *This is a response to the Examiner's Answer, Section (10) Response to Argument, GROUP 3, Claims 6 and 8-10, part (e), EA pages 24-25.*

[116] Wasteful Motivation

[117] The Examiner's Answer asserts that it would be obvious to modify Moshir in accordance with the teachings of Sakanishi. In the Final Action, the proposed motivation was to "efficiently handle software distribution as suggested by Sakanishi (e.g., col.3: 25-37)." In the Examiner's Answer, the motivation has been expanded to "to efficiently handle software distribution at least in part per usage data/priority levels to prevent any wasteful distribution, maintain the condition for using software being used remains satisfied, and/or determine whether which usage condition takes precedence and distribute or cancel software distribution as suggested by Sakanishi (e.g., col.3: 6-37, emphasis added)."

[118] However, Moshir only calls for installing critical updates, so, by definition, there are no wasteful updates. Moshir uses patch fingerprints to ensure a condition for installing an update is satisfied. This would cover determining which usage condition takes precedence and distributing or canceling software distribution. Thus, all the advantages offered by Sakanishi are already attained by Moshir.

[119] In the Final Action, the proposed motivation was to "efficiently handle software distribution as suggested by Sakanishi (e.g., col.3: 25-37)." The Appeal Brief responded that Moshir was not wasteful since the process was entirely automated. This argument is not addressed in the Examiner's Answer.

[120] ****End EA Response****

[121] **FAILURE OF PROPOSED COMBINATION TO MEET CLAIM LIMITATIONS**

[122] To the extent it is disclosed or implied in the references, prioritization appears to be performed by a user (Sakanishi) or a Corporate Entity (e.g., Microsoft, as in Moshir). Neither a user nor a corporation would qualify as a program encoded in computer-readable media as required by Claim 6. Furthermore, neither reference discloses prioritization as a function of usage data as required by Claim 6. Thus, however Moshir is modified in accordance with the teachings of Sakanishi, the combination would not meet the claim requirements for a prioritizer that prioritizes on the basis of usage data. **Since the proposed combination of references would not meet all the claim limitations, the rejection for obviousness of Claim 6 should be rejected for this fourth reason.**

[123] **Claims 8-10**

[124] The rejections of Claims 8-10 should be reversed in view of their dependency from Claim 6.

Claims Appendix

1. *(Previously presented)* A method comprising:
launching an application on a user system;
tracking usage of said application so as to generate usage data on said user system;
accessing an update site from said user system;
transferring said usage data from said user system to said update site;
said update site prioritizing updates for said application at least in part as a function of said usage data; and
said update site presenting to a user a list of said updates as prioritized in said prioritizing step.
2. *(canceled)*
3. *(Previously presented)* A method as recited in Claim 1 wherein said user selects one or more of said updates for said application.
4. *(original)* A method as recited in Claim 3 wherein said selected ones of said updates are installed so as to modify said application.

5. *(original)* A method as recited in Claim 1 wherein further development of said application is directed in part as a function of said usage data.

6. *(Previously presented)* A computer program product comprising computer-readable storage media encoded with a set of computer programs including:

a usage data evaluator for receiving and evaluating raw usage data provided by a user computer system regarding a version of a software application installed thereon, said usage data evaluator providing evaluated usage data;

an update prioritizer for prioritizing updates available for said version at least in part as a function of said evaluated usage data; and

a web interface for communicating with said user computer system via a browser on said user system so as to present to a user of said user computer system a list of said updates as prioritized by said prioritizer.

7. *(canceled)*

8. *(Previously presented)* A product as recited in Claim 6 wherein said web interface specifies, for at least some of said updates, advantages over said version of said application.

9. *(Previously presented)* A product as recited in Claim 6 further comprising a usage-tracking module installed on said user computer system.

10. *(Previously presented)* A product as recited in Claim 9 wherein said usage-tracking module is integrated with said version of said application.

EVIDENCE APPENDIX

None. No evidence is submitted with this Appeal Brief.

RELATED PROCEEDINGS APPENDIX

None. There are no related proceedings.